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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1975

No. 75-1045

CORNING GLASS WORKS, *Petitioner*

v.

FISCHER & PORTER COMPANY, *Respondent*

Petition for a Writ of Certiorari to The United States Court of Appeals For the Third Circuit

THOMAS M. FERRILL, JR.
ROGER NORMAN COE
ALLEN V. HAZELTINE
Attorneys for Petitioner, Corning Glass Works

106 Towle Building
Blue Bell, Pa. 19422

THE LEGAL INTELLIGENCER, 66 NORTH JUNIPER STREET, PHILA., PA. 19107 (215) 561-4050

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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1975

No.

Corning Glass Works, *Petitioner*

v.

Fischer & Porter Company, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

Corning Glass Works petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Third Circuit entered in the above case on October 30, 1975.

OPINIONS BELOW

The opinion of the Court of Appeals, not yet reported, appears at Appendix pages 1A & 2A hereto. Since this case was tried to a jury, no opinion was rendered by the District Court for the Eastern District of Pennsylvania.

JURISDICTION

The judgment of the Court of Appeals for the Third Circuit was entered on October 30, 1975. A timely petition for rehearing was denied on November 26, 1975, and this

FED THROUGH

petition for a writ of certiorari has been filed within 90 days of that date. The Court's jurisdiction is invoked under 28 U. S. C. §1254(1).

QUESTIONS PRESENTED

The questions here presented, which arose in a suit to recover royalties allegedly due under a patent license agreement in which validity of the licensed patent was contested by petitioner, are:

1. Where evidence was adduced tending to show that the patent was not granted in the names of the true inventors, was there a denial of due process under the Fifth Amendment of the United States Constitution where the trial court instructed the jury that 35 U. S. C. §256 provides that non-joinder or misjoinder of inventors can be corrected, but failed, despite timely objection, to instruct the jury as to the requirements imposed by that section for correctability of non-joinder or misjoinder?

2. Where the plaintiff-patentee claimed the benefit of the date of an earlier filed patent application, and evidence was adduced tending to show that the subject matter claimed in the patent in suit was known and used by others and on sale years prior to the date of said earlier application [35 U.S.C. §102(a)(b)], which information was not known to the U.S. Patent Office when the patent was granted, was there a denial of due process under the Fifth Amendment of the United States Constitution where the trial court instructed the jury that said evidence could greatly weaken or eliminate the presumption of validity accorded the patent under 35 U.S.C. §282 only if the jury should find that the patent was not entitled to the benefit of the date of said earlier patent application?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

CONSTITUTION

Article I, Section 8, Clause 8. Patents and copyrights

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

AMENDMENT V—CAPITAL CRIMES; DOUBLE JEOPARDY; SELF-INCRIMINATION; DUE PROCESS; JUST COMPENSATION FOR PROPERTY

No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offence to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

UNITED STATES CODE, TITLE 35

§102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

****

(f) he did not himself invent the subject matter sought to be patented, or

§103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§256. Misjoinder of inventor

Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner

may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

§282. Presumption of validity; defenses

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement

shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

STATEMENT OF THE CASE

This case involves a suit for damages for alleged breach of contract of a patent license agreement entered into July 1, 1960, between respondent Fischer & Porter Company (licensor) and petitioner Corning Glass Works (licensee).[1] The license agreement was based on U.S. Letters Patent No. 2,876,985 ('985 patent) directed to a form of a laboratory valve, commonly known as a stopcock, having a plastic plug rotatably positioned inside a glass valve housing or barrel.[2] The plastic plug has a transverse passage therethrough. The stopcock is turned on or off by turning the plastic plug. Fischer & Porter had the '985 patent issue in the names of George H. Birchall, Jr. and James A. Purdy as the alleged joint inventors.

The main issue in the case is the validity or invalidity of the licensed patent. Pursuant to a demand by Fischer & Porter, the suit was tried to a jury. Corning adduced evidence during the trial to show that the '985 patent is invalid on the grounds, *inter alia*, that:

(a) the patent did not issue in the names of the true inventors

and,

(b) the patent issued because the U. S. Patent Office Examiner was unable to find the most pertinent prior art.

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1. Basis for federal jurisdiction of the original cause of action was on the ground of diversity of citizenship pursuant to 28 U.S.C. §1332.

2. For convenience of the Court a sheet of drawings from the '985 patent is attached as appendix page 5A. Figure 1 of the drawings illustrates an assembled stopcock and Figure 2 shows separated labeled elements of the stopcock. Figure 4 shows another assembled stopcock with a compressed rubber ring instead of the wire spring in the stopcock of Figures 1 and 2.

As to each of these grounds, the trial court failed to instruct the jury correctly, and left it unable to understand the law applicable to the matters presented by the evidence.[3]

THE INSTRUCTION AS TO INVENTORSHIP OF AN ISSUED PATENT

The evidence at the trial was that Roger Gilman [sic; Gilmont], who was not a Fischer & Porter employee, proposed that Fischer & Porter use Teflon valve plugs in glass valve barrels (R. 4-111, 4-113, 4-114, 4-116, 4-119).[4] Conway, who was then employed by Fischer & Porter, worked out the plans for Teflon-plug valves and disclosed his drawings thereof to his fellow employee Purdy (R. 4-119). Fischer & Porter filed an application for patent in the names of Birchall and Purdy, omitting Conway and Gilmont. The testimony as to the inventive contribution by Conway and Gilmont was uncontradicted. Fischer & Porter tendered no evidence on the reasons for omitting Conway and Gilmont from the patent application.

In its final argument to the jury, Fischer & Porter dealt only with the evidence that Conway was an omitted co-inventor. It informed the jury that that ". . . would have made no difference to this lawsuit" contending that under 35 U.S. Code §256 non-joinder of an inventor is correctable (R. 7-122). In so arguing, Fischer & Porter failed to explain the limiting conditions of 35 U.S. Code §256—conditions precedent to gaining the benefit of that statute to avert invalidity under 35 U.S. Code §102(f).

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3. In the Judgment Order, it was mentioned that there was no motion for a new trial under F. R. Civ. P. 59(a). The fact was not relied on since, as held in *Kiernan v. Van Schaik*, 347 F.2d 775 at 777 (3 Cir., 1965);

> "Objections to rulings made at trial are ripe for review and need not be reiterated in the court below in a motion for a new trial. This is equally true whether no such motion is made or the objection is not included as a ground for new trial when a motion is filed."

4. The trial transcript, exhibits cited in this Appendix, and Appeal Appendix, Volume III have been certified and transmitted to this Court.

In the trial court's "overview" of the case, the jury was reminded of Conway's testimony regarding his contribution (R. 8-52), but no mention was made of the inventorship issue with respect to the non-Fischer & Porter employee Gilmont who made the original suggestion to Fischer & Porter that a stopcock be made having a plastic body (Teflon valve plug) inside the glass barrel (*supra*, p. 9).

After the trial court had correctly charged the jury that a patent is invalid if not obtained in the names of the true inventors (R. 8-36) Fischer & Porter, in the absence of the jury, urged the trial court to instruct the jury further that the third paragraph of 35 U.S. Code §256 provides that:

> ". . . misjoinder or non-joinder of joint inventors shall not invalidate a patent if such error can be corrected . . . (R. 8-62 and 8-63).

When Corning commenced its objection to this proposed instruction (R. 8-63), the trial court informed counsel that it would read Section 256 (erroneously reported in the transcript as Section 262) to the jury:

> "THE COURT: I think I can clear that up.
>
> * * * * *
>
> "THE COURT: I will read them 102 again, and I will supplement it by reading 262 [sic, 256] and tell them a misjoinder or non-joinder of joint inventors does not invalidate a patent." (R. 8-63).

Corning continued its objection noting that there are limits imposed on the correctability of inventorship and that merely reading the portion of Section 256 proposed by Fischer & Porter would not point out to the jury the conditions precedent as to error and absence of deceptive intent which must be met before errors in inventorship can be corrected (R. 8-63 and 8-64).[5]

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5. See *Rival Mfg. Co. v. Dazey Products Co.*, 358 F. Supp. 91 at 101 (W.D. Mo., 1973), which held a patent non-correctable to add omitted joint inventors because of inability to meet the conditions precedent of Section 256.

Disregarding this objection by Corning, and in compliance with Fischer & Porter's request for instruction, the trial court thereafter instructed the jury that the law ". . . says that misjoinder or non-joinder of joint inventors shall not invalidate a patent if such error can be corrected." (R. 8-77) The jury was never informed of conditions precedent for such correction and accordingly had to assume correctability of inventorship in reaching a decision.

THE INSTRUCTION AS TO PRIOR ART NOT CONSIDERED BY THE PATENT OFFICE EXAMINER

The U.S. Patent Office file of the '985 patent shows that in attempting to obtain allowance of the '985 patent application Fischer & Porter maintained that a stopcock having a plastic plug inside the glass barrel was novel:

> "As pointed out at the aforementioned interviews, applicants' valve forming the subject matter of claims 30 to 34 [claims 1 to 5 of the '985 patent] represents a valuable contribution to the art, in that it provides, for the first time, a vitreous valve housing with a dry tapered synthetic resin valve therein . . ." (App. III, 824a).[6]

The U.S. Patent Office Examiner advised Fischer & Porter that that was what he was looking for but was unable to find:

> ". . . None of the references specifically shows a Teflon valve plug cooperating with a glass valve seat." (App. III, 809a).

The Examiner noted that applicants were arguing that they were the "first ones" to combine a synthetic resin plug in

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6. Fischer & Porter admitted during the trial that the "valuable contribution to the art" which is referred to was something it was not able to make for years after it filed the '985 patent application in the Patent Office seeking to obtain exclusive rights on the alleged contribution. (Exhibit D156; R. 4-139).

a glass barrel (App. III, 811a). The Examiner further noted that none of the references which he had been able to find showed the arrangement of "a *glass* valve seat and a *synthetic resin* member" (App. III, 811a). Unable to find the more pertinent prior art (*i.e.*, prior art showing this arrangement), the Patent Office issued the '985 patent.

Corning established by depositions read at the trial that prior to any date asserted by Fischer & Porter for the '985 patent a small California company (Microchemical Specialties Company) then owned by Mr. Camenson had for many years commencing in 1948 been making and selling Teflon plug glass barrel stopcocks (R. 5-53, 5-77, 5-78, 8-65; Exhibits D-137, D-139, D-142). In view of the above-quoted comments by the U.S. Patent Office Examiner, the Camenson Teflon-plug glass barrel stopcocks were *a fortiori* more pertinent prior art than the prior art the Patent Office had considered. The stopcocks made by Camenson's company were exactly what the record shows the U.S. Patent Examiner had unsuccessfully attempted to find, when examining Fischer & Porter's stopcock patent application.[7]

In view of the *ex parte* arguments made by Fischer & Porter to the Patent Office, the recorded statements made by the U.S. Patent Office Examiner as to what he had not been able to find in the prior art before allowing the '985 patent, and the uncontradicted evidence relating to the manufacture and sale of Teflon-plug glass barrel stopcocks by Camenson's company in California by at least 1949, Corning requested the trial court to instruct the jury that the presumption of validity of the '985 patent under 35 U.S.C. §282 had been greatly weakened or overcome (R. 8-69 to 8-71). The instruction theretofore given to the jury was a generalized instruction (not specific to the Camenson

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7. For convenience of the Court, appendix page 5A illustrates the comparison between prior art found by the Patent Office Examiner (the Brewer patent), the Camenson stopcock, and the stopcock alleged to be novel by the '985 patent.

stopcock) with the added erroneous condition that more pertinent prior art not considered by the Patent Office could greatly weaken or eliminate the presumption of validity with respect to the '985 patent in suit *only if the jury should find that the patent was not entitled to the benefit of the earlier filing date of an '846 patent being claimed by Fischer & Porter:*

> "If you find that the '985 patent is not entitled to the 846 filing date and if you find that the prior art which was considered by the patent office when examining the application for the 985 patent did not include the closest prior art as exemplified by the published materials showing stopcocks with Teflon plugs in glass stopcock barrels or housings and material showing such stopcocks to have been on sale prior to June 22, 1954, that relates to one year prior to the date this was filed, you must find that the legal presumption of validity which ordinarily exists in favor of a patentee is greatly weakened, if not completely eliminated." (R. 8-20 and 8-21)

Corning objected because the trial court's instruction was such as to lead the jury to conclude that they were to weigh the question of early prior art overcoming the presumption of validity *only* if they should determine the patent in suit was not entitled to an earlier filing date. Corning had a right to rely on Camenson's Teflon-plug glass barrel stopcocks as prior art and that right did not depend upon whether or not Fischer & Porter was entitled to the 1951 date it was asserting. The trial court refused, however, to correct or amplify its instruction in this respect, its stated reason being that it was uncertain as to the meaning of "prior art." [8]

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8. As part of its earlier instruction to the jury, the trial court read the jury 35 U.S.C. §103 which requires an understanding of the words "prior art" for the Section to have meaning. The jury surely could not *sua sponte* determine the law's requirements as to the meaning of the expression "prior art."

"THE COURT: I am not too clear what is to be considered as prior art. I just don't know." (R. 8-67)

The failure of the trial court to correctly instruct the jury on this matter could only have led the jury to virtually disregard the Camenson prior art as having any material effect on the validity of the '985 patent.

REASONS FOR GRANTING THE WRIT

The Failure of the Court Below to Remand in View of the Jury Verdict Based on Erroneous Instructions by the Trial Court Constitutes a Denial of Due Process.

As hereinbefore pointed out, despite timely objection the trial court erroneously and inadequately charged the jury in two important respects, both of which were vital to the rendering of a proper verdict on the issue of validity of the patent in suit, as follows:

(1) While the trial court correctly charged the jury that a patent is invalid if not obtained in the names of the true inventors [35 U.S.C. §102(f)], the trial court rendered it impossible for the jury to determine this issue when it thereafter instructed the jury that non-joinder of inventors or a misjoinder of persons who are not in fact inventors can be corrected, without also instructing the jury as to the conditions precedent as to error and lack of deceptive intent imposed by 35 U.S.C. §256 for correction of non-joinder or misjoinder, and

(2) The trial court erroneously instructed the jury that evidence showing that the subject matter claimed in the patent suit was known and used by others prior to the date of an earlier patent application, the benefit of which was claimed by the plaintiff-patentee, greatly weakens or eliminates the presumption of validity of a patent under 35 U.S.C. §282 only if the jury should find that the patent was not entitled to the benefit of the date of said earlier application.

The Court of Appeals declined to remand the case for new trial on the ground that the charges to which there were objections "correctly stated the governing law" (App. 2A). Neither instruction correctly stated the governing law. As to the inventorship issue the trial court instructed the jury as to the part of 35 U.S.C. §256 re-

quested by Fischer & Porter. The remainder of the applicable law was not given to the jury. As to the prior art issue, the instruction by the trial court did not correctly state the law which has been repeatedly recognized by the Third Circuit. *Scripto, Inc. v. Ferber Corporation*, 267 F.2d 308 (3 Cir., 1959), *cert. den.*, 361 U.S. 864, 80 S.Ct. 122 (1959); *Dole Refrigerating Co. v. America Contact Plate Freezers*, 265 F.2d 627, 629 (3 Cir., 1959); *Chemical Construction Corp. v. Jones & Laughlin Steel Corp.*, 311 F.2d 367, 371 n. 1 (3 Cir., 1962); *Hadco Products, Inc. v. Walter Kidde*, 462 F.2d 1265, 1272, n. 33 (3 Cir., 1972), *cert. den.*, 409 U.S. 1023, 93 S.Ct. 464 (1972); *U. S. Expansion Bolt Company v. Jordan Industries, Inc.*, 488 F.2d 566, 569 (3 Cir., 1973) and *Fischer & Porter Co. v. Haskett*, 354 F. Supp. 464 (E.D. Pa., 1973), *affirmed*, 487 F.2d 1394 (3 Cir., 1973).

Corning was denied an opportunity to have these issues of patent validity fairly and fully presented to the jury for determination. This Court is the final arbiter of due process under the Constitution, *Gallagher v. Quinn*, 363 F.2d 301, 304 (Appeals D. C., 1966), *cert. den.*, 385 U.S. 881, 87 S.Ct. 167 (1966), and its review is needed in the present case to rectify a denial of due process.

The Decision Below, Approving Instructions to the Jury Which Rendered It Impossible for the Jury to Make a Proper Determination of Patent Validity, Conflicts With Constitutional Objectives of the Patent System.

This Court has recognized the duty of a trial court to give effect to the objectives of the patent system as set forth in Article I, Section 8 of the Constitution. *Graham v. John Deere Company of Kansas City*, 383 U.S. 1, 6, 86 S.Ct. 684, 688 (1966).

Article I, Section 8, Clause 8 of the Constitution provides that Congress shall have the power:

> "To promote the progress of science and useful arts, by securing for limited times to authors and

inventors the exclusive right to their respective writings and discoveries;"

Consistent with this provision, the patent statutes provide that:

(a) a patent may be granted only in the names of the true inventors (35 U.S.C. §102(f)) and,

(b) that a patent may be granted only for subject matter which is novel and unobvious (35 U.S.C. §102(a) and (b) and 35 U.S.C. §103).[9]

As hereinbefore pointed out, the instructions of the trial court to the jury in this case were misleading and inadequate to enable the jury to make a proper determination of either of these questions. Therefore, such instructions, approved by the Court of Appeals, are in conflict with the Constitutional provisions under which a patent may be granted only in the names of the true inventors and only for subject matter which is novel and unobvious. This constitutes sufficient reason for this Court to review the decision below.

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9. Pursuant to the decision of *Lear, Incorporated v. Adkins*, 395 U.S. 653, 674, 89 S.Ct. 1902, 1913 (1969) Corning challenged the validity of the '985 patent on these statutory grounds.

CONCLUSION

For the reasons presented herein, the exercise of this Court's power of supervision is needed in order to correct a denial of due process in connection with an affirming judgment of the Third Circuit which conflicts with the constitutional objective of the patent system.

Respectfully submitted,

Thomas M. Ferrill, Jr.
Roger Norman Coe
Allen V. Hazeltine
Counsel for Petitioner

106 Towle Building
Blue Bell, Pa. 19422

January 16, 1976

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

No. 75-1253

Fischer & Porter Company

v.

Corning Glass Works, *Appellant*

(D. C. Civil No. 70-2104)

Appeal from the United States District Court for the Eastern District of Pennsylvania

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Submitted Under Third Circuit Rule 12(6)
October 30, 1975

Before GIBBONS, Circuit Judge, MARKEY, Chief Judge, Court of Customs and Patent Appeals, WEIS, Circuit Judge

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JUDGMENT ORDER

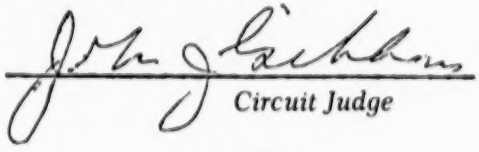
In a suit for royalties due on a patent license agreement the defendant-appellant asserted defenses of invalidity both under 35 U.S.C. §102 and under 35 U.S.C. §103, indefiniteness under 35 U.S.C. §112, non-infringement, and fraud on the patent office. The case was tried

to a jury which rendered a verdict for plaintiff-appellee. Appellant contends that the evidence was insufficient to submit the case to the jury, but it failed to make a motion for a directed verdict, Fed. R. Civ. P. 50(a) or for judgment notwithstanding the verdict, Fed. R. Civ. P. 50(b) or for a new trial. Fed. R. Civ. P. 59(a). It cannot in these circumstances be heard to complain that the trial court erred in submitting the case to the jury. *E.g. Follette v. National Tea Co.* 460 F.2d 254 (3d Cir. 1972); *Anderson v. Haas*, 341 F.2d 497 (3d Cir. 1965). Appellant also objects that the court erred in its charge in several respects. The claimed errors either were not objected to, Fed. R. Civ. P. 51, or correctly stated the governing law. Appellant also claims trial errors respecting the admission of evidence. We find none.

Appellee requests double costs and attorneys fees pursuant to 28 U.S.C. §1912. We decline to make such an order.

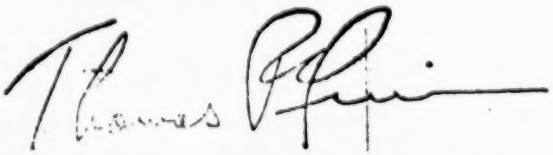
It is adjudged and ordered that the judgment of the district court be and hereby is affirmed. Costs taxed against appellant.

By the Court,



Circuit Judge

Attest



Thomas F. Quinn, Clerk

Dated: October 30, 1975

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

No. 75-1253

Fischer & Porter Company

v.

Corning Glass Works, *Appellant*

(D.C. Civil No. 70-2104)

SUR PETITION FOR REHEARING

Present: Seitz, Chief Judge, Van Dusen, Aldisert, Adams, Gibbons, Rosenn, Hunter, Markey, *Chief Judge, Court of Customs and Patent Appeals*, Weis and Garth, *Circuit Judges*

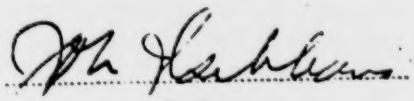
The petition for rehearing filed by

Appellant

in the above entitled case having been submitted to the judges who participated in the decision of this court and to all the other available circuit judges of the circuit in regular active service, and no judge who concurred in the decision having asked for rehearing, and a majority of the

circuit judges of the circuit in regular active service not having voted for rehearing by the court in banc, the petition for rehearing is denied.

By the Court,



Judge

Dated: November 26, 1975

March 10, 1959 G. H. BIRCHALL, JR., ET AL 2,876,985

ROTARY VALVES FOR LABORATORY GLASSWARE AND THE LIKE

Filed June 22, 1955 2 Sheets-Sheet 1

Fig. 1.

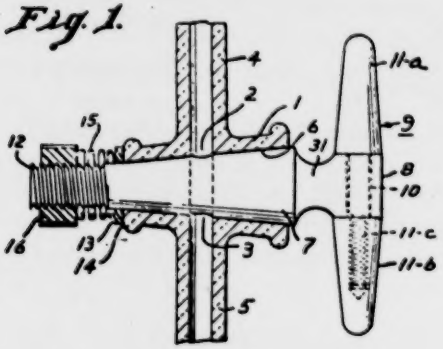


Fig. 3.

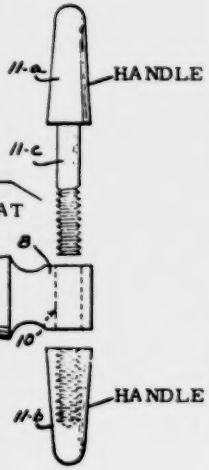
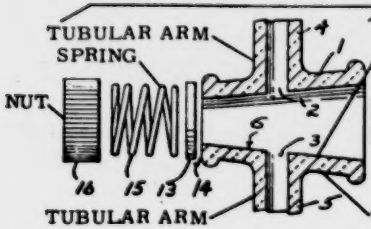


Fig. 2.



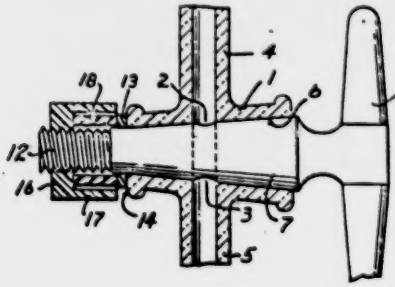


Fig. 4.

INVENTOR.
GEORGE H. BIRCHALL, JR.
JAMES A. PURDY.
BY
Edward L. Kalish
ATTORNEY

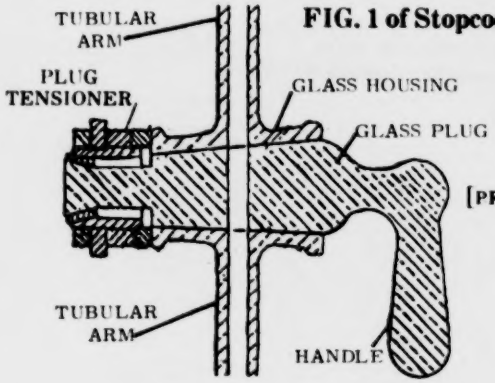
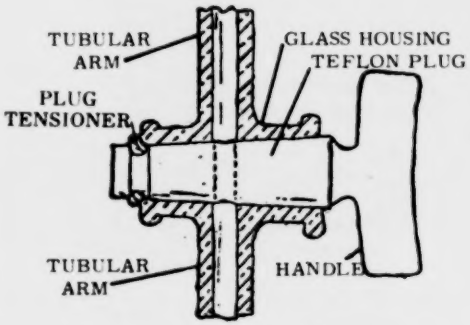


FIG. 1 of Stopcock Patent 2,412,597 to N. Brewer

Applied for March 1, 1944
Issued December 17, 1946
(Exhibit D 125)

[PRIOR ART CONSIDERED BY THE PATENT OFFICE]



Demonstrative Sketch Representing Camenson's "Misco" Teflon Plug Stopcock on Sale from 1948 (R 5-53 to 5-96 and Exhibits D137-D146)

[PRIOR ART NOT CONSIDERED BY THE PATENT OFFICE]

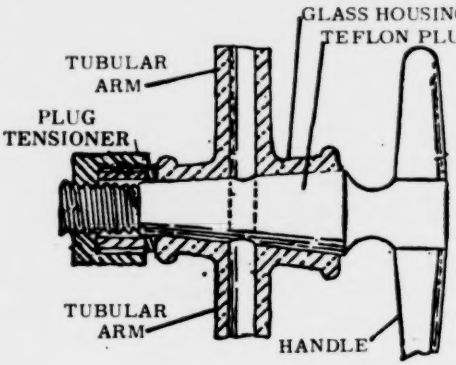


FIG. 4 from the '985 Patent in Suit

Applied for June 22, 1955
Issued March 10, 1959
(Exhibit P 6)

CERTIFICATION OF SERVICE

I, THOMAS M. FERRILL, Jr., Attorney for Petitioner Corning Glass Works, hereby certify that forty copies of the Petition for a Writ of Certiorari are being mailed to the Supreme Court of the United States, Washington, D.C. on January 16, 1976.

I also certify that three copies of the Petition are being mailed to the offices of Jay Tolson, Esq., Six Penn Center Plaza, Philadelphia, Pa. on January 16, 1976. In addition, three copies are being mailed first class, postage pre-paid, to John M. Calimafde, Esq., New York, N.Y. on January 16, 1976.

Thomas M. Ferrill, Jr.

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IN THE

Supreme Court of the United States

October Term, 1975

No. 75-1045

CORNING GLASS WORKS,
Petitioner,

v.

FISCHER & PORTER COMPANY,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

JOHN M. CALIMAFDE
Attorney for Respondent
60 East 42nd Street
New York, New York 10017

Of Counsel:
JAMES M. RHODES, JR.
FRANCIS J. MURPHY
HOPGOOD CALIMAFDE, KALIL,
BLAUSTEIN & LIEBERMAN
60 East 42nd Street
New York, N. Y. 10017

IN THE

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CORNING GLASS WORKS,

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FISCHER & PORTER COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Petitioner has requested this Court to grant a Writ of Certiorari to review the judgment of the court below which held that petitioner cannot be "heard to complain that the trial court erred in submitting the case to the jury" when petitioner failed to make a motion for a directed verdict, or for judgment notwithstanding the verdict or for a new trial (2A). The court below also held that petitioner cannot be heard to complain in regard to the court's charges to the jury since the "claimed errors either were not objected to Fed. R. Civ. P. 51, or correctly stated the governing law" (2A).

BLEED THROUGH

The petitioner is asking this Court to decide factually pregnant questions of non-joinder or mis-joinder of inventorship and other highly technical questions concerning the effective date of prior art. It is difficult to imagine questions less suitable for consideration by this Court than those presented by petitioner.

Statement

Respondent does not accept petitioner's statements and characterization of the record, but since the merits of the petition are not affected, respondent does not burden this brief in opposition by a detailed statement.

This action began in the trial court as an action for nonpayment of royalties and breach of a patent license contract in which petitioner, The Corning Glass Works, defended on the ground that the licensed patent was invalid for a multiplicity of reasons, and that its slightly modified version of a royalty bearing product avoided the patent. The action was tried before a jury, and the jury rendered a general verdict for respondent, Fischer & Porter Company.

The parties stipulated to a eight-man-jury trial and agreed that the case should be submitted for a general verdict. The very questions presented to this Court were presented to the jury, and the jury rendered a verdict in favor of respondent in all respects.

Petitioner, Corning, did not move for a directed verdict at the conclusion of respondent's case or at the conclusion of all the evidence. After receiving the unfavorable verdict,

it did not move for a judgment n.o.v. Instead, Corning took an appeal from the judgment on the verdict and attempted to reargue all the issues *de novo* before the Court of Appeals. Simply and colloquially stated, Corning gambled on the jury verdict, lost, and asked the Court of Appeals to cover its bet. It lost again before the Court of Appeals and now asks this Court to overturn the verdict.

Reason for Opposition

The issues of non-joinder and mis-joinder of inventorship, and the issue of whether a continuation-in-part patent application is entitled to the filing date of the parent application are by their very nature highly technical questions requiring a detailed understanding of facts. The facts were duly presented to the jury and the jury rendered a verdict in favor of respondent.

There is no dispute between the circuits in regard to the issues which petitioner would like this Court to consider *de novo,* and the issues are substantially devoid of any public interest.

The presentation of the "factual record" by petitioner, Corning, is in fact a tendentious view of respondent's counsel and in many respects is a distortion of the record. The same type of argument was presented to the Court of Appeals and from that Court's opinion, it is apparent that the Court saw through the distorted presentation of so-called facts. Indeed, one can glean from the Court's judgment that little or no respect was accorded to substantially the same argument which is presented to this Court.

BLEED THROUGH

It would, we submit, unduly burden this brief and belabor the Court to engage in an extensive factual presentation to rebut the allegations of so-called facts presented by petitioner.

In view of the almost total lack of any public interest inherent in this case, the lack of any inconsistencies between the circuits in regard to the issues, and in view of the highly technical nature of the issues involved, it is hard to imagine a case less suited for review by this Court.

Accordingly, the Petition should be denied.

Respectfully submitted,

/s/ JOHN M. CALIMAFDE

JOHN M. CALIMAFDE
Attorney for Respondent
60 East 42nd Street
New York, New York 10017

Of Counsel:
JAMES M. RHODES, JR.
FRANCIS J. MURPHY
HOPGOOD CALIMAFDE, KALIL,
BLAUSTEIN & LIEBERMAN
60 East 42nd Street
New York, N. Y. 10017

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1975

No. 75-1045

CORNING GLASS WORKS, *Petitioner*

v.

FISCHER & PORTER COMPANY, *Respondent*

PETITIONER'S REPLY BRIEF

THOMAS M. FERRILL, JR.
ROGER NORMAN COE
Attorneys for Petitioner,
Corning Glass Works

106 Towle Building
Blue Bell, Pa. 19422

THE LEGAL INTELLIGENCER, 66 NORTH JUNIPER STREET, PHILA., PA. 19107 (215) 561-4850

TABLE OF CITATIONS

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35 U.S.C. §286 3

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1975

No. 75-1045

Corning Glass Works, *Petitioner*

v.

Fischer & Porter Company, *Respondent*

PETITIONER'S REPLY BRIEF

Respondent incorrectly argues on page 2 of its brief that ". . . petitioner is asking this Court to decide factually pregnant questions of non-joinder or misjoinder of inventorship and other highly technical questions concerning the effective date of prior art" and that "The very questions presented to this Court were presented to the jury. . . ." This incorrectly states the point of the petition.

Fact questions on the issues of inventorship and effective date of the more relevant prior art were presented by the evidence to be weighed by the jury. Over petitioner's objections, the instructions given to the jury failed to state the governing law so as to enable the jury to understand the law applicable to these matters presented by the evidence. The jury was accordingly left to assume that the presumption of validity had not been overcome.

The purpose for which this Court is being petitioned for a writ of certiorari is not what respondent imputes to petitioner (*i.e.* to decide factual questions); rather it is to review the question whether complete and correct instructions as to the applicable law on the two issues,

each underlying the ultimate issue of validity, were required for due process, and whether, despite the timely objections, incorrect instruction in one case and the failure to even provide instruction in the other case deprived petitioner of a fair trial.

Respondent also incorrectly argues at page 4 that there is an ". . . almost total lack of any public interest inherent in this case. . . ." To the contrary, there is inherent public interest in obtaining a ruling that a jury must be correctly instructed as to the law's requirements on each issue presented for determination. There could hardly be a matter more fundamental to our system of trial by jury, and a ruling is needed that this applies no less to a patent case than to other fields of law.

The public interest inherent in this case has a further aspect, namely, the public needs to be protected from reliance by the patentee on an invalid patent. In *Aero Spark Plug Co. v. B. G. Corporation*, 130 F.2d 290, 294 (2 Cir., 1942) Judge Frank observed that "An invalid patent masquerading as a valid one is a public menace. . . ."[1] As this Court stated in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330 (1945):

> "It has come to be recognized, however, that of the two questions [infringement and validity], validity has the greater public importance, Cover v. Schwartz, 2 Cir., 133 F. 2d 541 [,545], and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

---

1. In the *Aero* case, Judge Frank went on to state:

"It is no adequate answer to say that courts should not concern themselves with the protection of persons not parties to suits pending before them. The fact is that courts daily do so concern themselves, and in circumstances where the desirability of doing so is far less obvious than here and the means far less effective. Because I think that to hold invalid a patent which is obviously void is a matter of *major public importance*. . . ." (emphasis added)

This is no mere academic matter in the present case. Respondent's patent issued March 10, 1959; it expires March 10, 1976. The statute of limitations on patent infringement suits is 6 years (35 U.S.C. §286). Upon obtaining a judgment based upon the verdict of the incorrectly instructed jury in the present case, respondent instituted suits under this patent against other producers of Teflon-plug glass-barrel stopcocks, two of whom (Kontes Glass Co. and Lurex Manufacturing Co., Inc.) had been making such products ever since 1951 and 1952, *i.e.*, from several years before respondent Fischer & Porter even found out how to make Teflon-plug glass-barrel stopcocks.[2]

Thus, contrary to respondent's contentions, (a) the issue presented for this Court to decide is not "factually pregnant questions" but a question of necessary instruction of the jury as to the governing law, and (b) there is substantial public interest in this case. Accordingly, the petition should be granted.

Respectfully submitted,

Thomas M. Ferrill, Jr.
Roger Norman Coe
Counsel for Petitioner
Suite 106, Towle Building

February 27, 1976

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2. This Court is requested to take judicial notice of Fischer & Porter's suits filed February 27, 1975, against Kontes Glass Co. and March 21 1975, against Lurex Manufacturing Co., Inc. in the District Court for the District of New Jersey, Civil Actions Nos. 75-0339 and 75-0472, respectively, charging infringement of the patent here involved.

CERTIFICATION OF SERVICE

I, THOMAS M. FERRILL, JR., Attorney for Petitioner Corning Glass Works, hereby certify that forty copies of Petitioner's Reply Brief are being mailed to the Supreme Court of the United States, Washington, D. C. on February 27, 1976.

I also certify that three copies of the Reply Brief are being mailed to the offices of Jay Tolson, Esq., Six Penn Center Plaza, Philadelphia, Pa. on February 27, 1976. In addition, three copies are being mailed first class, postage pre-paid, to John M. Calimafde, Esq., New York, N. Y. on February 27, 1976.

Thomas M. Ferrill Jr

THOMAS M. FERRILL, JR.